UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

NOV - 7 1997

Paper No. 42

In re Application of
Phillippe J. H. Berna
Serial No. 08/580,493
Filed: December 29, 1995
For: PROCESS FOR MAKING A VERSATILE CLAMPING DEVICE DESIGNED TO HOLD OBJECTS WITHOUT DAMAGING THEM, SUCH A DEVICE AND ITS USE

: DECISION ON PETITION
: TO REPLACE EXAMINER

The present application is a continuation of application serial number 08/321,589 (hereinafter "the parent application"). On January 22, 1996, applicant filed a petition in the parent application to replace the Primary Examiner. However, the parent application was abandoned at the time that this petition was filed. As the present application has now been restored to pending status, the petition originally filed in the parent application will now be considered herein.

The petition is DENIED.

The petition alleges "prejudice" on the part of the Primary Examiner, because the Primary Examiner is "clearly biased". The petition relies upon 28 USC § 144 as statutory basis for replacing the Primary Examiner on this basis.

By its terms, 28 USC § 144 applies only to matters pending in a district court, and permits a party to such matter to file a timely affidavit which suffices to prove bias in order to remove the judge from hearing the matter. As the Primary Examiner is not a judge in a matter before a district court, but is an employee of an Executive Branch agency, 28 USC § 144 clearly does not apply. This is so notwithstanding applicant's reliance upon the Equal Protection Clause of the Fourteenth Amendment to the United States Constitution as equating the Primary Examiner to a judge. Suffice it to say that the Equal Protection Clause has no such application. Moreover, even assuming, *arguendo*, that 28 USC § 144 applied, applicant has filed no affidavit establishing prejudice or bias.

Applicant is advised that under Section 1.181 of Title 37 of the Code of Federal Regulations (37 CFR § 1.181), the Commission of Patents and Trademarks has the authority to entertain a petition to remove the Primary Examiner. Therefore, this petition has been thoroughly reviewed, together with the prosecution history of the parent application and the present application. This review shows that the Primary Examiner has taken a position adverse to patentability, with which applicant disagrees.

However, the record fails to establish any basis for holding that the Primary Examiner is biased or prejudiced against applicant, and the instant petition likewise fails to establish any basis for so holding. That applicant and the Primary Examiner disagree as to the patentability of the claimed invention simply does not establish bias or prejudice on the part of the Primary Examiner. As in any legal proceeding, it is the often the nature of patent application prosecution for two parties to disagree. The record shows that while the Primary Examiner disagrees with applicant on patentability, the Primary Examiner has not abused his discretion, has not acted in any arbitrary or capricious manner, and has not exhibited any conduct or attitude that reflects bias or prejudice against applicant.

It is noted that this application received an Office action on October 17, 1996. Applicant replied on January 21, 1997. Thereafter, this application was in the process of being revived from abandonment pursuant to 37 CFR § 1.137(b), and no attention to the January 21, 1997 reply was possible. A review of that reply now shows that the reply is a *bona fide* attempt to respond to the Office letter dated October 17, 1996, but is not a complete response. Due to the long delay between its filing and the determination that the reply is incomplete, it appears advisable to vacate the October 17, 1996 Office letter in favor of a new action.

The Office letter dated October 17, 1996 is hereby VACATED. This application is being returned to the Supervisory Patent Examiner of Patent Examining Art Unit 3206 who, together with the Primary Examiner, will review applicant's response dated January 17, 1997. Thereafter, the Primary Examiner will promulgate a new Office action setting a three month shortened statutory period for response. The new Office action should be written in light of the issues raised in applicant's reply dated January 17, 1997 which applicant advances as reasons why the reply could not address all of the matters raised in the vacated Office letter. Applicant is advised that a response to an Office action must address every issue raised therein. Only formal matters may be held in abeyance, and any response filed by applicant should particularly request the same in the event that applicant desires to hold certain formal matters in abeyance.

PETITION DENIED.

E. Rollins-Cross, Director
Patent Examining Group 3200

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